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Patent
Attorney's Docket No. 027556-430

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Patent Application of)
U.S. Patent No. 5,109,528 to) Group Art Unit: 2746
Jan-Erik UDDENFELDT et al.)
Serial No.: 08/938,840) Examiner: E. Urban
Filed: September 26, 1997)
For: HANOVER METHOD FOR)
MOBILE RADIO SYSTEM)

NOTICE REGARDING LITIGATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to M.P.E.P. § 1442.04 and 37 C.F.R. § 1.56, please note that the above-identified patent is involved in litigation. Specifically, this patent is involved in litigation in the Northern District of Texas, Docket No. 96 cv 3373 and in the Northern District of California, Docket No. C96-2074. The enclosed documents highlight the defenses of which the undersigned is aware which have been raised in the former litigation and which are related to the validity of the patent. Other documents associated with alleged non-infringement are not included herewith, because the undersigned has been informed that these documents have been (retroactively) placed under seal by the Court. These documents, however, were submitted (apparently before being placed under seal) in a related reissue prosecution application, Serial No. 08/136,760 filed October 23, 1993 for

Reissue Patent Application of U.S. Patent No. 5,109,528
Attorney's Docket No. 027556-430

"Cellular Digital Mobile Radio System And Method Of Transmitting Information In A Digital Cellular Mobile Radio System" issued to Jan-Erik Uddenfeldt et al.

The Examiner is invited to review the documents in the related application. At this point, the undersigned is not aware of additional defenses having been raised in this litigation alleging any charges of fraud or inequitable conduct, or any other details and documents, other than those already submitted in an Information Disclosure Statement, associated with the litigation that could be considered "material to patentability" pursuant to 37 C.F.R. § 1.56.

No fees are believed to be due by submission of this document. If, however, fees are needed the Commissioner is hereby authorized to charge any such fees to Deposit Account No. 02-4800. This paper is submitted in triplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____


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Date: August 24, 1998

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

ERICSSON INC. and TELEFONAKTIEBOLAGET)
LM ERICSSON,)
Plaintiffs,) No. 3-96CV3373-JP
v.)
QUALCOMM PERSONAL ELECTRONICS,)
Defendant.)

**QUALCOMM PERSONAL ELECTRONICS' SECOND SUPPLEMENTAL RESPONSE
TO PLAINTIFFS' FIRST SET OF INTERROGATORIES**

Pursuant to Federal Rule of Civil Procedure 33 and in compliance with Magistrate Judge Kaplan's March 2, 1998 order, Defendant Qualcomm Personal Electronics ("QPE") provides these supplemental responses to the First Set of Interrogatories served by plaintiffs Ericsson Inc. and Telefonaktiebolaget LM Ericsson (collectively "Ericsson"). In supplementing its responses to these interrogatories, QPE incorporates by reference the General Objections it raised to these interrogatories in its initial responses dated May 14, 1997.

INTERROGATORY NO. 3:

For each claim of each of the Ericsson Patents in Suit which Qualcomm contends is invalid under 35 U.S.C. §§ 101, 102, or 112, as pleaded in part by Qualcomm in Paragraph 15 of its Answer (Restated) and Paragraph 4 of Qualcomm's Amended Declaratory Judgment

Counterclaim, state each and every fact supporting the grounds for such pleadings and identify all prior art supporting these contentions.

SECOND SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 3:

In addition to QPE's General Objections, QPE objects to this interrogatory on the grounds that it is overbroad and unduly burdensome. Ericsson to date has identified only one claim of each patent in suit as allegedly infringed by QPE. Thus, this interrogatory needlessly requires QPE to address a large number of claims that Ericsson has not placed in issue. Moreover, the information sought by this interrogatory is premature. This is because, *inter alia*, the validity or invalidity of a patent claim or element of a claim depends upon the interpretation that is afforded such claim or claim element. Thus, the invalidity analyses sought are tentative and incomplete in that they do not have the benefit of the final claim interpretations by the Court or the benefit of Ericsson's alleged claim interpretations due to Ericsson's refusal to furnish such interpretations. Furthermore, Ericsson has failed to produce evidence of conception of the alleged inventions or evidence of diligence in reducing the alleged inventions to practice. Consequently, without such production, QPE cannot at present fix the dates which are relevant in determining the scope and content of the prior art—a necessary prerequisite for establishing invalidity under certain provisions of section 102. In addition, QPE's validity investigations are ongoing and QPE is continuing to receive and evaluate additional prior art that may be relevant to the invalidity or unenforceability of the patent claims in issue. Finally, QPE's ability to establish its best mode defenses under section 112 are dependent on Ericsson's compliance with orders compelling Ericsson to produce its CDMA and TDMA source code—orders that Ericsson is refusing to comply with while such orders are being appealed.

Subject to QPE's general and specific objections, and subject to QPE's reservation of the right to supplement and modify its responses as additional information and analysis is conducted, QPE will provide such information responsive to this interrogatory as has been tentatively determined to date, with respect to those claims which Ericsson has expressly identified in its responses to QPE's first set of interrogatories. Accordingly, QPE reserves the right to add additional invalidity arguments, whether based on prior art or based on the failure of the patents to comply with section 112, should Ericsson identify additional claims allegedly infringed by the QPE Accused Products. Based upon information currently available, QPE incorporates its prior responses and supplements its responses as follows:

Patent 5,169,528 (Claim 4) and Patent 5,327,577 (Claim 7):

Under a proper claim interpretation, the QPE Accused Products do not infringe the '528 or '577 patents. Indeed, as properly construed, the '528 and '577 claims do not read on the QPE Accused Products, the IS-95 standard, or any CDMA method or system, as discussed in QPE's responses to Interrogatory No. 1. Should the Court adopt QPE's claim interpretation, QPE need not go forward with its invalidity allegations.

QPE's invalidity counterclaims and defenses, like QPE's noninfringement defenses, necessarily depend on the scope of the claims. Depending upon the claim construction adopted by the Court, the claims will be either (1) not infringed, (2) invalid, or (3) both. In all likelihood, QPE will not be required to demonstrate that the claims are invalid if the Court has already held that QPE does not infringe. Thus, if the Court determines the proper scope of the claims before it addresses validity, the Court may not need to consider QPE's invalidity defenses.

As of the date of these responses, QPE and Qualcomm (in a parallel, first-filed action in Marshall, Texas) have asked Ericsson to explain its claim interpretation so that QPE and

Qualcomm may understand Ericsson's allegations, focus on the areas of disagreement, and refine and narrow the noninfringement and invalidity disputes. Unfortunately, Ericsson has refused to explain what its duplicative lawsuits are about, in spite Court orders compelling it do so in the Marshall litigation.

As a consequence, QPE must necessarily guess at Ericsson's claim interpretation in order to respond to this interrogatory. QPE therefore reiterates its general objection that it is unduly burdensome to require QPE to apply the prior art against a claim interpretation that Ericsson refuses to disclose. Notwithstanding the foregoing, QPE's invalidity defenses were plead in good faith and based upon prior art, which QPE has already disclosed to Ericsson and which would support an invalidity defense against apparent claim interpretations Ericsson might propose. QPE has already specifically identified the following prior art as supporting its invalidity defenses regarding claim 4 of the '528 patent and claim 7 of the '577 patent: U.S. Patent Nos. 4,596,042, 4,697,260, 4,718,081, 4,723,266, 4,737,978, 4,759,051 and 4,955,082, as well as Japanese Patent Abstract, Vol. 9, No. 169 (E-328), EPO Application No. 0274857; and two articles by Berhardt entitled "User Access in Portable Radio Systems" and "RF Performance of Macroscopic Diversity in Universal Digital Portable Radio Communications." Although QPE cannot provide a detailed analysis until Ericsson provides its claim construction, QPE believes that this prior art discloses systems that expressly or inherently practice the claims that Ericsson is now attempting to assert against QPE. In addition, QPE identifies the following prior art supporting invalidity defenses to the unknown, but apparently broad, claim construction that Ericsson may espouse: U.S. Patent Nos. 4,112,257, 4,698,839 and 4,856,048; and two articles by Nakajima et al. entitled "Advanced Mobile Communication Network Based on Signaling System No. 7."

This additional prior art discloses, either expressly or inherently, systems in which multiple base stations transmit to a single mobile station. Once Ericsson commits to a claim interpretation, QPE will supplement its analysis and will then provide a more detailed explanation of how Ericsson's interpretation would render the claims invalid in light of this prior art. In addition, once Ericsson commits to a claim interpretation, QPE may be able to identify additional prior art that invalidates the claims, at least as Ericsson construes them.

Finally, nothing in the specification or drawings supports Ericsson's apparent interpretation that the claims cover spread spectrum technology, much less code-division multiple access ("CDMA") technology. QPE has scrutinized the specification and drawings and is unable to find any disclosure whatsoever supporting Ericsson's apparent interpretation or mentioning CDMA systems and methods. Thus, to the extent that Ericsson is successful in convincing the Court that the claims should be interpreted as covering CDMA systems, the written description appears to be inadequate under section 112 since there is no written description of a method for practicing CDMA or spread spectrum technology. Furthermore, Ericsson's undisclosed, but apparently broad interpretation would render the claims invalid under section 112 for failure to claim what the applicant regards as his invention.

Patent 5,088,108 (Claim 1)

Under a proper claim interpretation, the QPE Accused Products do not infringe the '108 patent. Indeed, as properly construed, the '108 claims do not read on the QPE Accused Products, the IS-95 standard, or any CDMA method or system, as discussed in QPE's responses to Interrogatory No. 1. Should the Court adopt QPE's claim interpretation, QPE need not go forward with its invalidity allegations.

As of the date of these responses, QPE and Qualcomm (in a parallel, first-filed action in Marshall, Texas) have asked Ericsson to explain its claim interpretation so that QPE and Qualcomm may understand Ericsson's allegations, focus on the areas of disagreement, and refine and narrow the noninfringement and invalidity disputes. Unfortunately, Ericsson has refused to explain what its duplicative lawsuits are about, in spite Court orders compelling it do so in the Marshall litigation.

As a consequence, QPE must necessarily guess at Ericsson's claim interpretation in order to respond to this interrogatory. QPE therefore reiterates its general objection that it is unduly burdensome to require QPE to apply the prior art against a claim interpretation that Ericsson refuses to disclose. Notwithstanding the foregoing, QPE's invalidity defenses were plead in good faith and based upon prior art, which QPE has already disclosed to Ericsson and which would support an invalidity defense against apparent claim interpretations Ericsson might propose. QPE has already specifically identified the following prior art as supporting its invalidity defenses regarding claim 1 of the '108 patent: U.S. Patent Nos. 4,097,804, 4,255,814, 4,383,332, 4,516,267, 4,675,863, 4,696,051, 4,696,052, 4,718,109, 4,759,051, as well as EPO Application Nos. 10731, 72479, 72984, 234857, FRG Application No. 3022425, and Articles by Raith, Heynisch, Stjernall, and Heft cited in QPE's supplemental responses. Although QPE cannot provide a detailed analysis until Ericsson provides its claim construction, QPE believes that this prior art discloses systems that expressly or inherently practice the claim that Ericsson is now attempting to assert against QPE. In addition, QPE identifies the following prior art supporting invalidity defenses to the unknown, but apparently broad, claim construction Ericsson may espouse: U.S. Patent Nos. 4,097,804, 4,383,332, 4,852,090, and 4,490,830.

This additional prior art discloses, either expressly or inherently, multipath signal reception and equalization in cellular systems. Once Ericsson commits to a claim interpretation, QPE will supplement its analysis and will then provide a more detailed explanation of how Ericsson's interpretation would render the asserted claim invalid in light of this prior art. In addition, once Ericsson commits to a claim interpretation, QPE may be able to identify additional prior art that invalidates the claim, at least as Ericsson construes it.

Finally, nothing in the specification or drawings supports Ericsson's apparent interpretation that the claims of the '108 patent cover spread spectrum technology, much less code-division multiple access ("CDMA") technology. QPE has scrutinized the specification and drawings and is unable to find any disclosure whatsoever supporting Ericsson's apparent interpretation or mentioning CDMA systems and methods. Thus, to the extent that Ericsson is successful in convincing the Court that the claims should be interpreted as covering CDMA systems, the written description of the '108 patent appears to be inadequate under section 112 since there is no written description of a method for practicing CDMA or spread spectrum technology. Furthermore, Ericsson's undisclosed, but apparently broad interpretation would render the claims invalid under section 112 for failure to claim what the applicant regards as his invention.

Patent 5,148,485 (Claim 62)

Under a proper claim interpretation, the QPE Accused Products do not infringe claim 62 of the '485 patent, as discussed in QPE's responses to Interrogatory No. 1. Should the Court adopt QPE's claim interpretation, QPE need not go forward with its invalidity allegations.

As of the date of these responses, QPE and Qualcomm (in a parallel, first-filed action in Marshall, Texas) have asked Ericsson to explain its claim interpretation so that QPE and